

The Court of Appeals for the Federal Circuit has determined that definiteness of claim language must be analyzed, not in a vacuum, but in light of (1) the content of the particular application disclosure, (2) the teachings of the prior art, and (3) the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. *See, e.g., In re Marosi, Stabenow, and Schwarzman*, 710 F.2d 799, 803, 218 U.S.P.Q. 289, 291 (Fed. Cir. 1983).

Appellants submit that the meaning of the phrase "without substantially increasing the copper number" is not indefinite under 35 U.S.C. §112, second paragraph. Appellants submit that the phrase "without substantially increasing the copper number" is clear to a person of ordinary skill, either based on the plain and ordinary meaning of the words themselves, and also by referring to the present specification.

The term "substantially" is often used in conjunction with another term to describe a particular characteristic of the claimed invention. It can be a broad term. *In re Nehrenberg*, 280 F.2d 161, 165, 126 U.S.P.Q. 383, 386 (C.C.P.A. 1960). The limitation "to substantially increase the efficiency of the compound as a copper extractant" was definite in view of the general guidelines contained in the specification. *In re Mattison*, 509 F.2d 563, 565, 184 U.S.P.Q. 484, 486-87 (C.C.P.A. 1975). The court in *Andrew Corp. v. Gabriel Electronics* held that the limitation "which produces substantially equal E and H plane illumination patterns" was definite because one of ordinary skill in the art would know what was meant by "substantially equal." *Andrew Corp. v. Gabriel Electronics*, 847 F.2d 819, 823-824, 6 U.S.P.Q.2d 2010, 2013-14 (Fed. Cir. 1988).

Words of degree, such as "substantially," are addressed in the case, *Exxon v. United States*, 265 F.3d 1371, 60 U.S.P.Q.2d 1272 (Fed. Cir. 2001). In this Federal Circuit case, the phrase "for a period sufficient to increase substantially the initial catalyst activity" did not render the claim invalid for indefiniteness, because a person of ordinary skill would understand what the patentee intended, even though the patent did not specify which method was used to calculate the increase in productivity. *Id.* at 1375, 1278.

As the above cases distinctly point out, the term "substantially" is not indefinite if one of ordinary skill in the art would understand what was meant by the phrase at issue. It is apparent that the Examiner has understood the phrase by referring to the specification. It is, therefore, apparent that a person of ordinary skill would also understand the phrase by referring to the specification.

The Examiner is imposing a subjective opinion that the phrase is indefinite because the meaning is supposedly contrary to an "accepted" meaning. See page 4 of the Office Action mailed on September 16, 2003, where the Examiner states "[t]he argument that Applicant is

LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{PLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100

allowed to define terms is correct. However, the definitions must be within that conventionally used in the art. The art would not recognize a doubling of copper number to be "without substantial increasing." However, there is no evidence in the record other than the Examiner's unsupported assertion of what is the commonly accepted meaning of "substantially." Appellants submit that there can be no prior commonly accepted meaning of the phrase because the inventive process is novel, and the phrase is one of degree. Regardless, appellants have unambiguously defined, "without substantially increasing the copper number," in the specification to be without increasing the copper number by more than about 100%, preferably not more than about 50% and most preferably not more than about 25% during the D.P. reduction step. Please see the present specification on page 16, lines 8-11. One of ordinary skill would readily understand what is meant by the phrase "without substantially increasing the copper number" by merely referring to the specification. "If the claims, read in light of the specification, reasonably apprise those skilled in the art both of the utilization and scope of the invention, and if the language is as precise as the subject matter permits, the courts can demand no more." See *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1385, 231 U.S.P.Q. 81, 94-95 (Fed. Cir. 1986), citing *Shatterproof Glass Corp. v. Libbey Owens Ford Co.*, 758 F.2d 613, 624, 225 U.S.P.Q. 634, 641 (Fed. Cir. 1985).

Accordingly, the withdrawal of the rejection of Claims 1-11 under 35 U.S.C. §112, second paragraph, is respectfully requested.

The Rejection of Claims 1-11 Under Obviousness Type Double-Patenting

Claims 1-11 are provisionally rejected under the judicially created doctrine of obviousness-type double-patenting as being unpatentable over Claims 1-19 of co-pending Application No. 10/128,973; or over Claims 1-8 of Application No. 10/128,975 (now U.S. Patent No. 6,861,023). Applicants respectfully disagree.

A proper obviousness-type double patenting rejection requires that the claim being rejected define an invention that is merely an obvious variation of an invention being claimed in a pending application. In this instance, the claims in the present application are related to a process for making a composition for conversion to a lyocell fiber and lack two steps recited in Claim 1 of U.S. Patent No. 6,861,023; and lack a step recited in Claim 1 of Application No. 10/128,973. An identical step or any step that is merely obvious of such missing steps is absent from the claims of the present application. Applicants submit that if there is no step in the present claims that is merely an obvious variation of one or more steps that are recited in the claims of the '023 patent or the '973 application, there can be no obviousness-type double patenting.

LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{PLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100

"Domination" and double patenting should not be confused. They are two separate issues. One patent or application "dominates" a second patent or application when the first patent or application has a broader generic claim which fully encompasses or reads on an invention defined in a narrower or more specific claim in another patent or application. Domination by itself, i.e., in the absence of statutory or nonstatutory double patenting grounds, *cannot support a double patenting rejection.*" [Emphasis added.] See M.P.E.P. §804.II., pp. 800-820; *In re Kaplan*, 789 F.2d 1574, 1577-78, 229 U.S.P.Q. 678-681 (Fed. Cir. 1986); and *In re Sarrett*, 327 F.2d 1005, 1014-15, 140 U.S.P.Q. 474, 482 (C.C.P.A. 1964). Applicants submit that the claims of the present application may dominate the claims of the '023 patent and the claims of the '973 application, but without the same step or a merely obvious step being recited in the present claims, does not automatically imply double-patenting.

A double patenting rejection of the obviousness-type is "analogous to [a failure to meet] the nonobviousness requirement of 35 U.S.C. §103" except that the patent principally underlying the double patenting rejection is not considered prior art. *In re Braithwaite*, 379 F.2d 594, 154 U.S.P.Q. 29 (C.C.P.A. 1967). Therefore, any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. §103 obviousness determination. *In re Braat*, 937 F.2d 589, 19 U.S.P.Q.2d 1289 (Fed. Cir. 1991); *In re Longi*, 759 F.2d 887, 225 U.S.P.Q. 645 (Fed. Cir. 1985). Since the analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 U.S.C. §103(a) rejection, there must first be a motivation or suggestion to combine references or to modify a reference, there must be a reasonable expectation of success, and all the claim elements must be taught or suggested in the prior art references.

To render the present claims obvious over the claims of the '023 patent, means that the claims of the '023 patent would need to be modified to eliminate the step of "forming fibers from the pulp treated in accordance with step (b)." However, as the claims of the '023 patent are directed to a "process for making lyocell fibers", elimination of the fiber forming step would destroy the intended purpose of the claims. Accordingly, there is no suggestion or motivation to modify the claims of the '023 patent to result in the claims of the present application.

To render the present claims obvious over the claims of the '973 application, means that the claims of the '973 application would need to be modified to eliminate the step of "pulping a raw material in a digester to provide an alkaline pulp, wherein the raw material comprises sawdust in an amount greater than 25% up to 100%." However, nothing in the '973 application teaches or suggests that this step should be eliminated. Applicants submit that the invention defined by the claims of the '973 application rely on the discovery that sawdust may be

LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{PLLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100

converted into a pulp suitable for use in lyocell fiber production. The claims of the '973 application rely on this step combined with the other step not being taught or suggested in the prior art, therefore, the claims of the '973 application would be rendered meaningless if such step were eliminated. Accordingly, there is no suggestion or motivation to modify the claims of the '973 application to result in the claims of the present application.

Furthermore, applicants submit that should there only be a provisional double patenting rejection remaining in this application, because the double patenting rejection over the '023 patent is overcome, this application should be allowed to issue. See M.P.E.P. § 822.01.

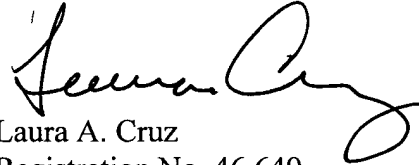
Accordingly, for the reasons stated above, Claims 1-11 are not obvious over Claims 1-19 of co-pending Application No. 10/128,973; and over Claims 1-8 of Application No. 10/128,975 (now U.S. Patent No. 6,861,023).

CONCLUSION

In view of the foregoing discussion, applicants respectfully submit that Claims 1-11 are in condition for allowance. If the Examiner has any further questions or comments, the Examiner may contact the applicants' attorney at the number provided below.

Respectfully submitted,

CHRISTENSEN O'CONNOR
JOHNSON KINDNESS^{PLLC}

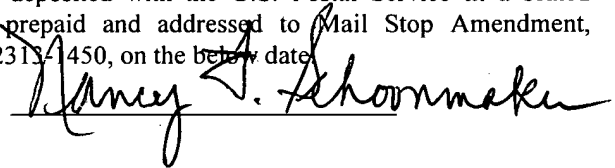


Laura A. Cruz
Registration No. 46,649
Direct Dial No. 206.695.1725

I hereby certify that this correspondence is being deposited with the U.S. Postal Service in a sealed envelope as first class mail with postage thereon fully prepaid and addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the below date:

Date:

8/5/05



LXC:ejh/nfs

LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{PLLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100